

**REMARKS/ARGUMENTS**

Claims 18-20 and 36-44 are pending and stand substantively rejected. Claims 1-17 and 21-35 are canceled, and claims 43 and 44 are withdrawn. Reconsideration is respectfully requested.

**I. New Matter Rejection**

The Office Action at page 2 requests the Applicant to cancel new matter. However, no description of the alleged new matter is provided. If this rejection is maintained, clarification is requested.

**II. Rejection Under 35 U.S.C. §101**

Claims 18-20 and 36-42 were rejected under 35 U.S.C. §101 as allegedly drawn to non-statutory subject matter. This rejection is traversed.

The Advisory Action mailed October 25, 2006 stated that the §101 rejection is not applicable to at least claim 39. However, the instant Office Action offers no explanation as to why the Advisory Action has been reversed with respect to claim 39. If this rejection as applied to claim 39 is maintained, clarification is requested.

Moreover, the Examiner's Answer mailed February 9, 2007 (page 4) stated that the §101 rejection was not based on the "mental steps" test for non-statutory subject matter. However, the instant Office Action offers no explanation as to why the Examiner's Answer has been reversed with respect to the "mental steps" rejection. If this rejection is maintained, clarification is requested.

In the interest of compact prosecution, the traverse of the "mental steps" rejection, as previously set forth in response to the Office Action of June 15, 2006 (page 3), is reiterated below.

**A. The "Mental Step" Test Is Improper**

The law regarding non-statutory subject matter is discussed in *In re Musgrave*, and further guidance can be found in The Interim Guidelines For Examination Of Patent Applications For Patent Subject Matter Eligibility.

In re Musgrave (167 USPQ 280, Fed. Cir. 1970)

This case recites the rule that it is improper to reject a claim as directed to a non-statutory process merely because some or all the steps therein can also be carried out in or with the aid of the human mind. At issue was whether the claims directed to establishing weathering corrections in seismic exploration were properly rejected as non-statutory on the basis that they involved mental steps. The Court found that it was improper to reject the claims merely because some or all of the method steps involved processes of the human mind.

Interim Guidelines, Subject Matter Eligibility (OG Not. 11/22/05)

The Interim Guidelines caution that "USPTO personnel *should no longer rely on the mental step test* to determine whether a claimed invention is directed to statutory subject matter." (Emphasis added).

The foregoing court decision and Interim Guidelines clearly establish that it is improper to rely upon a "mental steps" test to support a non-statutory subject matter rejection under 35 U.S.C. §101.

Withdrawal of this rejection is respectfully requested.

**III. First Ambiguous Rejection**

At the first paragraph of page 3, the Office Action says "the applied combination" teaches the claimed method. However, it is not clear *what references* are included in "the applied combination." Moreover, this paragraph of the Office Action does not specify *what claims* are being analyzed in view of the applied combination. Further, the *statutory basis* for this rejection (e.g. 35 U.S.C. §103) is not identified. If this rejection is maintained, clarification is requested.

**IV. Second Ambiguous Rejection**

At the second paragraph of page 3, the Office Action addresses claim 36 and mentions the Burns and Seibel references. However, the *statutory basis* for this rejection (e.g. 35 U.S.C. §103) is not identified. Moreover, as previously stated and reiterated below, Seibel is not prior art.

USPN 6,563,105 to Seibel et al. was filed 8/23/01, and published on 10/3/02. The patent issued 5/13/03. Seibel was not published before the instant application was filed, and thus

cannot qualify as a §102(a) reference. Seibel was not published more than one year before the instant application was filed, and thus cannot qualify as a §102(b) reference. Seibel was filed before the instant application was filed but not before the instant priority provisional was filed. Support for the present pending claims can be found in the instant priority provisional application at, for example, page 11, line 11 to page 13, line 4, Figs. 5-6A, and the originally filed claims, including claims 1, 9, and 10. Thus, Seibel cannot qualify as a §102(e) reference. Seibel therefore cannot be relied upon for a rejection of claim 36.

If this rejection is maintained, clarification is requested.

**V. Rejection under 35 U.S.C. §103**

Claims 18-20 and 36-42 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,834,238 [“Hochman”] in combination with U.S. Patent No. 6,280,435. [“Odrich”] and U.S. Patent No. 6,486,943 [“Burns”]. This rejection is traversed.

The instant application was filed 12/6/01, and claims priority to provisional application no. 60/254,313 filed 12/8/00. At the time the presently claimed invention was made, it was owned or subject to an obligation of assignment to VISX Incorporated.

The Odrich application was filed 3/3/99, and issued 8/28/01. The Odrich application claims priority to provisional application no. 60/076,786 filed 3/4/98. Odrich was published before the instant application was filed, but not before the instant provisional application was filed, and thus cannot qualify as a §102(a) reference. Odrich was not published more than one year before the instant application was filed, and thus cannot qualify as a §102(b) reference. Odrich was filed before the instant application was filed and the Odrich provisional was filed before the instant provisional, and thus Odrich can only qualify as a §102(e) reference. Odrich was, at the time the presently claimed invention was made, owned by or subject to an obligation of assignment to VISX Incorporated. Thus, Odrich, which could only qualify under 102(e), shall not preclude patentability because of the common ownership provisions of 35 U.S.C. §103(c). In sum, according to MPEP 706.02(I)(I)(I), Odrich cannot properly be included in the proposed §103(a) rejection.

Moreover, this §103 rejection incorrectly addresses only claim 18. A proper rejection must individually address each of the pending claims, on the merits. Withdrawal of this rejection is respectfully requested.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Nathan S. Cassell/

Nathan S. Cassell  
Reg. No. 42,396

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
61963060 v1